REMARKS

This Application has been carefully reviewed in light of the Office Action dated June 12, 2008 (*"Office Action"*). At the time of the *Office Action*, Claims 1-32 were pending and rejected. Applicants have amended Claims 1, 14, and 28. Applicants submit that no new matter has been added by these amendments. As described below, Applicants believe all claims to be allowable over the cited references. Therefore, Applicants respectfully request reconsideration and full allowance of all pending claims.

Information Disclosure Statement

On May 30, 2008, Applicants electronically filed an Information Disclosure Statement (IDS) and PTO-1449 Form listing references submitted for consideration. Copies of the cited references were also included. The Examiner has not indicated consideration of the references cited in the IDS. Accordingly, Applicants hereby request confirmation of consideration of the IDS filed on May 30, 2008. For the convenience of the Examiner, copies of the IDS filed May 30, 2008, the PTO-1449 Form, and the acknowledgement receipt are being submitted herewith.

Section 112 Rejections

The Examiner rejects Claims 1-32 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner identifies that the term "the business rules" as recited in Claims 1, 14, and 28 lack antecedent basis. (*Office Action*, page 2). Applicants have amended the claims to address the issues identified by the Examiner. Applicants respectfully request that the rejections under 35 U.S.C. § 112, second paragraph be withdrawn.

Section 102 Rejections

The Examiner rejects Claims 28-29 and 31-32 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,536,659 issued to Hauser et al. (*"Hauser"*).

Independent Claim 28 of the present Application, as amended, recites:

A computer product for providing merchandise return labels for enabling a customer to ship a package containing one or more items previously acquired from a merchant during a unique transaction, comprising programming operable to:

access item data representing at least one detail about the item;

access transaction data representing at least one detail about the transaction associated with the item;

correlate the item data and transaction data with a set of stored business rules to determine coding to be printed on a shipping label; wherein the set of stored business rules specify how packages are to be shipped and represent guidelines for determining a selected shipping carrier, a shipping destination, and a shipping class or rate;

in response to correlating the item data and transaction data with the set of stored business rules specifying how packages are to be shipped, generate a machine readable code for the return shipping label, wherein the data represents the results of the correlating step and represents at least a shipping origin of the package and identification of the transaction; and

in response to correlating the item data and transaction data with the set of stored business rules specifying how packages are to be shipped, format the return shipping label, such that the return shipping label contains the machine readable code and complies with shipping label specifications of the selected shipping carrier.

Whether considered alone or in combination with any other cited references, *Hauser* does not disclose, either expressly or inherently, each and every element of the claims.[1]

For example, *Hauser* does not disclose, teach, or suggest programming operable to "correlate the item data and transaction data with a set of stored business rules to determine coding to be printed on a shipping label; wherein the set of stored business rules specify how packages are to be shipped and represent guidelines for determining a selected shipping carrier, a shipping destination, and a shipping class or rate," as recited in Applicants' Claim 28. With respect to a shipping label, *Hauser* merely discloses that customers "are provided with a return authorization shipping label by the returns facility." (*Hauser*, Abstract). Specifically, "[u]pon receiving the data from a merchant who has authorized the return of merchandise, Returns Online, Inc. will generate a return authorization shipping label."

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[1] "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); MPEP § 2131. In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); MPEP § 2131 (*emphasis added*).

(*Hauser*, Column 4, lines 16-19). The return shipping label "may include either a prepaid United States Postal Service Postage Permit or other private shipper forms." (*Hauser*, Column 4, lines 26-30). The return shipping label "includes the address for Returns Online, Inc., and a bar code that is scannable for identifying the merchant and merchandise being returned." (*Hauser*, Column 6, lines 21-27). *Hauser* does not disclose, however, programming operable to "correlate the item data and transaction data with a set of stored business rules to determine coding to be printed on a shipping label; wherein the set of stored business rules specify how packages are to be shipped and represent guidelines for determining a selected shipping carrier, a shipping destination, and a shipping class or rate," as recited in Applicants' Claim 28.

The *Office Action* points to column 6, lines 50-65 for disclosure of Applicants' correlating step. However, the cited portion of *Hauser* merely discloses that a "bar code tag 71 indicating the disposition is applied to the returned merchandise or to container 60" and that "container 60 and/or returned merchandise 62 is directed onto an automated conveyor system 70." (*Hauser*, Column 6, lines 50-53). However, bar code tag 71 relates to a tag that is applied at a processing station at the returns center only after the processing and inspection of the container. (*Hauser*, Column 6, lines 43-49; see also, Figure 1, reference numerals 26-32; Figure 2, reference numeral 62). Thereafter, "the disposition indicated on bar code tag 71 is scanned using a scanner 64c," and the conveyor system "direct[s] the returned merchandise to an appropriate temporary storage bin." (*Hauser*, Column 6, lines 56-60). Thus, bar code 71 relates to the final disposition of an item as determined after processing at the Returns Center and not to the shipping of the item. Thus, to the extent that *Hauser* discloses correlating data with business rules, such correlating and such business rules are not related to the generation of a shipping label. Accordingly, *Hauser* does not disclose programming operable to "correlate the item data and transaction data with a set of stored business rules to determine coding to be printed on a shipping label; wherein the set of stored business rules specify how packages are to be shipped and represent guidelines for determining a selected shipping carrier, a shipping destination, and a shipping class or rate," as recited in Applicants' Claim 28.

As further examples, *Hauser* does not disclose, teach, or suggest programming operable to "in response to correlating the item data and transaction data with the set of stored business rules specifying how packages are to be shipped, generate a machine readable code for the return shipping label, wherein the data represents the results of the correlating step and represents at least a shipping origin of the package and identification of the transaction" and "in response to correlating the item data and transaction data with the set of stored business rules specifying how packages are to be shipped, format the return shipping label, such that the return shipping label contains the machine readable code and complies with shipping label specifications of the selected shipping carrier," as recited in Applicants' Claim 28. As stated above, *Hauser* merely discloses that Returns Online, Inc. will generate a prepaid United States Postal Service Postage Permit or other private shipper forms that "includes the address for Returns Online, Inc., and a bar code that is scannable for identifying the merchant and merchandise being returned." (*Hauser*, Column 4, lines 16-19; Column 4, lines 26-30; Column 6, lines 21-27). Accordingly, *Hauser* does not disclose a set of stored business rules specifying how packages are to be shipped and, thus, does not disclose Applicants' recited claim elements.

For at least these reasons, Applicants request reconsideration and allowance of independent Claim 28, together with Claims 29 and 31-32 that depend on Claim 28.

Section 103 Rejections

The Examiner rejects Claims 1-27 and 30 under 35 U.S.C. 103(a) as being unpatentable over *Hauser* in view of U.S. Patent Application Publication No. 2004/128265 issued to Holtz et al. ("*Holtz*").

Independent Claim 1 of the present Application, as amended, recites:

A computer-implemented method of providing merchandise return labels for enabling a customer to ship a package containing one or more items previously acquired from a merchant during a unique transaction, comprising the steps of:

accessing item data representing at least one detail about the item;

accessing transaction data representing at least one detail about the transaction associated with the item;

accessing customer data representing at least one detail about a customer associated with the transaction;

accessing package data representing at least one detail about the package in which the item is expected to be shipped;

correlating the item data, transaction data, customer data, and package data, with a set of stored business rules to determine coding to be printed on a return shipping label; wherein the set of stored business rules specify how packages are to be shipped and represent guidelines for determining choice of carrier, shipping destination, shipping rate, and package disposition;

in response to correlating the item data, transaction data, customer data, and package data with the set of stored business rules specifying how packages are to be shipped, generating a machine readable code for the return shipping label, wherein the data represents the results of the correlating step and represents at least a shipping origin of the package and identification of the transaction; and

in response to correlating the item data, transaction data, customer data, and package data with the set of stored business rules specifying how packages are to be shipped, formatting the return shipping label, such that the return shipping label contains the machine readable code and complies with shipping label specifications of the choice of carrier.

Thus, Claim 1 recites certain claim elements that are similar to those discussed above with regard to Claim 28. The *Office Action* relies upon *Hauser*, specifically, for disclosure of the Applicants' steps of "correlating," "generating," and "formatting." (*Office Action*, pages 5-6). However, Applicants have shown above with regard to Claim 28 that *Hauser* does not disclose the recited claim elements. Because *Holtz* does not relate to the generation of a shipping label and does not cure the deficiencies discussed above, Applicants respectfully submit that Claim 1 is allowable over the proposed *Hauser-Holtz* combination.

As a further example of the deficiencies of the cited references, Applicants respectfully submit that the proposed *Hauser-Holtz* combination does not disclose, teach , or suggest "accessing package data representing at least one detail about the package in which the item is expected to be shipped," as recited in Claim 1. The *Office Action* acknowledges that the recited claim elements are not disclosed in *Hauser* and instead relies upon *Holtz*. (*Office Action*, page 6). However, *Holtz* relates to the processing of return merchandise postal workers after such items are received at the mail center. Specifically, *Holtz* states that "the

mail delivery process begins when one or more delivery trucks deposit unsorted or "raw" mail, which includes various types of envelopes, packages, or other articles for delivery to different destinations, upon a processing site." (*Holtz*, Page 1, paragraph 9). According to *Holtz*, workers "calculate the postage due for each package based on, among other things, the weight, the origin, and the destination of the package, for example." (*Holtz*, Page 2, paragraph 13). Thus, postal workers "must perform the time consuming processing steps" related to the delivery of postage manifests "during the night before delivery, or during the early hours of the day before packages can be delivered." (*Holtz*, Page 2, paragraph 14). To aid in the preparation of these manifests, *Holtz* discloses "a processing workstation" in the postal center that is "configured to allow an operator to perform postage due calculations remote from the processing path based upon the package image and the weight information in the database network." (*Holtz*, Page 2, paragraph 16). Thus, *Holtz* does not at all relate to the generation of a return shipping label. To the extent that *Holtz* discloses "accessing package data representing at least one detail about the package," such package data relates to an actual package and not to a "package in which the item is **expected** to be shipped," as recited in Claim 1.

For at least these reasons, Applicants request reconsideration and allowance of independent Claim, together with Claims 2-13 that depend on Claim 1. For analogous reasons, Applicants also request reconsideration and allowance of independent Claim 14, together with Claims 15-27 that depend on Claim 14.

Claim 30 depends upon independent Claim 28, which Applicants have shown above to be allowable. Thus, Claim 30 is not obvious over the cited references at least because Claim 30 include the limitations of Claim 28.

Additionally, Claim 30 recites claim elements that further distinguish the art. For example, dependent Claim 30 recites that the "programming is further operable to access package data representing at least one detail about the package in which the item is expected to be shipped, and to further correlate package data with the business rules." Applicants have shown above that the similar claim elements recited in Claims 1 and 28 are not

disclosed, taught, or suggested by the prior art of record. Accordingly, for reasons similar to those discussed above, Applicants respectfully submit that Claim 30 is patentable over the cited references..

CONCLUSION

Applicants have made an earnest attempt to place this Application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request reconsideration and full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Jenni R. Moen, Attorney for Applicants, at the Examiner's convenience at (214) 953-6809.

Although no fees are believed due, the Commissioner is hereby authorized to charge any fees or credits to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
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